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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,722	04/16/2004	Russell F. McKnight	ACER-45262	1771
116 7590 10/15/2009 PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			EXAMINER UBER, NATHAN C	
			ART UNIT 3622	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/826,722	<b>Applicant(s)</b> MCKNIGHT ET AL.	
	<b>Examiner</b> NATHAN C. UBER	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,10 and 19-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3, 10 and 19-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the RCE filed on 01 September 2009.
2. Claims 1, 3, 10 and 19-22 have been amended.
3. Claims 23-25 have been added.
4. Claims 11 and 12 have been canceled.
5. Claims 1, 3, 10 and 19-25 are currently pending and have been examined.

### **Continued Examination Under 37 CFR 1.114**

6. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01 September 2009 has been entered.

### **Claim Rejections - 35 USC § 112**

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
8. Claims 1, 10 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 10 and 21 recite the limitation "the user's request". There is insufficient antecedent basis for this limitation in the claims.

### **Claim Rejections - 35 USC § 103**

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1, 3, 19 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett (US 6,473,738 B1) in view of Jacobi et al. (US 7,113,917 B2) and in view of Song (U.S. 6,865,546 B1).

**Claim 1:**

Garrett, as shown, discloses the following limitations:

- *establishing, by the computerized transaction system without requiring the user's request, the giftee profile based on said determining if the computerized transaction is associated with the user on behalf of the third party, wherein the giftee profile corresponds to the third party and is associated with a user profile corresponding to the user (see at least column 8, lines 48-56, profiles for the user and for the recipients are established; Examiner notes that the Garrett invention does not required the user to request a profile to be established, one is established automatically when a recipient is indicated for a particular purchase),*
- *aggregating, by the computerized transaction system, information associated with the transaction in the user profile corresponding to the user if the computerized transaction is determined to be associated with the user (see at least column 3, lines 52-53, "saving the selection list;" see also at least figure 6, purchase history log for user and each recipient),*

- *aggregating, by the computerized transaction system, the information associated with the transaction in the giftee profile corresponding to the third party if the computerized transaction is determined to be associated with the third party* (see at least column 3, lines 52-53, “saving the selection list;” see also at least figure 6, purchase history log for user and each recipient),

Garrett gives the purchaser the opportunity to indicate at the beginning of the shopping transaction or at check-out whether the items purchased/selected are for the purchaser or for third parties. The Garrett invention requires the user/purchaser to interact with buttons in the online interface (i.e. prompts) in order to designate items for intended recipients. Garrett does not specifically disclose that the server can determine the intended recipient of an item without the user/purchaser using the online prompts to designate a recipient. However, Song, as shown, discloses a server that can distinguish intended recipients of an online purchase based on the “ship to” information:

- *determining, by the computerized transaction system without prompting the user whether the computerized transaction is associated with the user or whether the computerized transaction is associated with the user on behalf of a third party* (see at least column 5, lines 1-3 and 10-12, the system may infer that an item is being purchased as a gift by for example recognizing that the shipping address for the item is different from the billing address),

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the inference-determining feature of the Song invention with Garrett’s online shopping tools because both inventions seek to assist users in making online purchases, the Song inference feature only requires input data (shipping and billing addresses) which the Garrett invention also requires, both inventions seek to compartmentalize purchase histories by recipient and since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

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Garrett further does not specifically disclose the following additional limitations, but Jacobi, as shown, does:

- *determining, by the computerized transaction system, an offer tailored to one or more of the user or to the third party based upon either the user profile corresponding to the user or the giftee profile corresponding to the third party (see at least column 6, lines 14-22, provides recommendations based on items in user's list),*
- *presenting, by the computerized transaction system, the offer to the user, wherein the offer comprises one or more of a special offer, a promotion, a product recommendation, and a product suggestion (see at least column 4, lines 55-61, implementing a variety of recommendation services... generates personal recommendations),*
- *the offer, if tailored for the third party, is based upon the giftee profile corresponding to the third party and is not based upon the user profile corresponding to the user (see at least column 6, lines 23-37, user designates shopping carts for different people (self, children , etcetera) and recommendations are made based on current shopping cart contents or past shopping cart purchases/selections, but are specific to a particular designated shopping cart),*
- *the offer, if tailored to the user, is based upon the user profile corresponding to the user and is not based upon the giftee profile corresponding to the third party (see at least column 6, lines 23-37, user designates shopping carts for different people (self, children , etcetera) and recommendations are made based on current shopping cart contents or past shopping cart purchases/selections, but are specific to a particular designated shopping cart),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the capacity to differentiate between purchase histories and item

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selections for various parties within one user's account (the invention of Garrett) with the automated generation of product promotions/recommendations based on shopping cart content and previous purchases (the invention of Jacobi, also taught by Song) as well as with the inference determination feature of Song since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claim 3:**

The combination Garrett/Jacobi/Song discloses the limitations as shown in the rejections above. Further, Garrett, as shown, discloses the following limitations:

- *determining if the giftee profile corresponding to the third party is already present* (see at least column 6, line 42, the list of parties can be displayed),
- *establishing the giftee profile corresponding to the third party if the giftee profile is not already present* (see at least column 3, lines 46-47, generating... a list of names... the customer may associate items with),
- *updating, by the computerized transaction system, the information associated with the transaction in the giftee profile corresponding to the third party if the giftee profile is already present in the profile* (see at least column 3, lines 52-53, "saving the selection list;" see also at least figure 6, purchase history log for user and each recipient).

**Claims 19 and 22:**

The combination Garrett/Jacobi/Song discloses the limitations as shown in the rejections above. Garrett does not specifically disclose offers. However, Jacobi, as shown, discloses the following limitation:

- *the determining of the offer is based upon a past purchase transactions and the presented offer is for a future purchase by the user* (see at least column 6, line 33-37, uses items that were purchased as basis for offers),

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine capacity to differentiate between purchase histories and item selections for various parties within one user's account (the invention of Garrett) with the automated generation of product promotions/recommendations based on shopping cart content and previous purchases (the invention of Jacobi) since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claim 21:**

Garrett, as shown, discloses the following limitations:

- *establishing, by the computerized transaction system without requiring the user's request, the giftee profile based on said determining if the computerized transaction is associated with the user on behalf of the third party, wherein the giftee profile corresponds to the third party and is associated with a user profile corresponding to the user (see at least column 8, lines 48-56, profiles for the user and for the recipients are established; Examiner notes that the Garrett invention does not required the user to request a profile to be established, one is established automatically when a recipient is indicated for a particular purchase),*
- *aggregating, by the computerized transaction system, information associated with the purchase transaction in the user profile corresponding to the user if the computerized purchase transaction is determined to be associated with the user (see at least column 3, lines 52-53, "saving the selection list;" see also at least figure 6, purchase history log for user and each recipient),*
- *aggregating, by the computerized transaction system, the information associated with the purchase transaction in the giftee profile corresponding to the third party if the computerized purchase transaction is determined to be associated with the third party (see at least column 3, lines 52-53, "saving*



the selection list;” see also at least figure 6, purchase history log for user and each recipient),

Garrett gives the purchaser the opportunity to indicate at the beginning of the shopping transaction or at check-out whether the items purchased/selected are for the purchaser or for third parties. The Garrett invention requires the user/purchaser to interact with buttons in the online interface (i.e. prompts) in order to designate items for intended recipients. Garrett does not specifically disclose that the server can determine the intended recipient of an item without the user/purchaser using the online prompts to designate a recipient. However, Song, as shown, discloses a server that can distinguish intended recipients of an online purchase based on the “ship to” information:

- *determining, by the computerized transaction system without prompting the user whether the computerized transaction is associated with the user or whether the computerized transaction is associated with the user on behalf of a third party* (see at least column 5, lines 1-3 and 10-12, the system may infer that an item is being purchased as a gift by for example recognizing that the shipping address for the item is different from the billing address),

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the inference-determining feature of the Song invention with Garrett’s online shopping tools because both inventions seek to assist users in making online purchases, the Song inference feature only requires input data (shipping and billing addresses) which the Garrett invention also requires, both inventions seek to compartmentalize purchase histories by recipient and since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Garrett further does not specifically disclose the following additional limitations, but Jacobi, as shown, does:

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- *determining, by the computerized transaction system, an offer tailored to one or more of the user or to the third party based upon either the user profile corresponding to the user or the giftee profile corresponding to the third party (see at least column 6, lines 14-22 provides recommendations based on items in user's list),*
- *presenting, by the computerized transaction system, the offer to the user, wherein the offer comprises one or more of a special offer, a promotion, a product recommendation, and a product suggestion (see at least column 4, lines 55-61, implementing a variety of recommendation services... generates personal recommendations),*
- *the offer, if tailored for the third party, is based upon the giftee profile corresponding to the third party and is not based upon the user profile corresponding to the user (see at least column 6, lines 23-37, user designates shopping carts for different people (self, children , etcetera) and recommendations are made based on current shopping cart contents or past shopping cart purchases/selections, but are specific to a particular designated shopping cart),*
- *the offer, if tailored to the user, is based upon the user profile corresponding to the user and is not based upon the giftee profile corresponding to the third party (see at least column 6, lines 23-37, user designates shopping carts for different people (self, children , etcetera) and recommendations are made based on current shopping cart contents or past shopping cart purchases/selections, but are specific to a particular designated shopping cart),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the capacity to differentiate between purchase histories and item selections for various parties within one user's account (the invention of Garrett) with the automated generation of product promotions/recommendations based on shopping cart

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content and previous purchases (the invention of Jacobi, also taught by Song) as well as with the inference determination feature of Song since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claims 23-25:**

The combination Garrett/Jacobi/Song discloses the limitations as shown in the rejections above. Further, Song, as shown, discloses the following limitations:

- *said determining whether the computerized transaction is associated with the user or whether the computerized transaction is associated with the user on behalf of the third party/said distinguishing is made by judging if a “ship to” party matches the user (see at least column 5, lines 1-3 and 10-12, the system may infer that an item is being purchased as a gift by for example recognizing that the shipping address for the item is different from the billing address),*

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the inference-determining feature of the Song invention with Garrett's online shopping tools because both inventions seek to assist users in making online purchases, the Song inference feature only requires input data (shipping and billing addresses) which the Garrett invention also requires, both inventions seek to compartmentalize purchase histories by recipient and since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

12. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett (US 6,473,738 B1) in view of Jacobi et al. (US 7,113,917 B2).

**Claim 10:**

Garrett, as shown, discloses the following limitations:

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- *initiating a computerized transaction with the user by the merchant for a subject using the computerized transaction system (see at least column 6, line 16-20, log-on),*
- *receiving, by the computerized transaction system, from the user an indication of whether the subject of the computerized transaction is intended for use by the user or by a third party (see at least column 3, lines 50-52, the customer indicates while shopping that an item is intended for a third party),*
- *distinguishing in the computerized database system, by the computerized transaction system without prompting the user, between the subject of computerized transactions by the user that is intended for use by the user and the subject of computerized transactions by the user that is intended for use by the third party (see at least figure 6, once the user indicates whom the item is intended for (see the above limitation) the server automatically distinguishes between the items and compiles separate purchase histories),*
- *establishing, by the computerized transaction system without requiring the user's request, the giftee profile based on said determining if the computerized transaction is associated with the user on behalf of the third party, wherein the giftee profile corresponds to the third party and is associated with a user profile corresponding to the user (see at least column 8, lines 48-56, profiles for the user and for the recipients are established; Examiner notes that the Garrett invention does not required the user to request a profile to be established, one is established automatically when a recipient is indicated for a particular purchase),*
- *aggregating the information associated with the transaction in the user profile corresponding to the user if the subject of the computerized transaction is determined to be associated with the user (see at least column 3, lines 52-53, "saving the selection list;" see also at least figure 6, purchase history log for user and each recipient),*

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- *aggregating the information associated with the transaction in the giftee profile corresponding to the third party if the subject of the computerized transaction is determined to be associated with the third party (see at least column 3, lines 52-53, "saving the selection list;" see also at least figure 6, purchase history log for user and each recipient),*

Garrett does not specifically disclose the following additional limitations, but Jacobi, as shown, does:

- *determining, by the computerized transaction system, an offer tailored to one or more of the user or to the third party based upon either the user profile corresponding to the user or the giftee profile corresponding to the third party (see at least column 6, lines 14-22 provides recommendations based on items in user's list),*
- *presenting, by the computerized transaction system, the offer to the user, wherein the offer comprises one or more of a special offer, a promotion, a product recommendation, and a product suggestion (see at least column 4, lines 55-61, implementing a variety of recommendation services... generates personal recommendations),*
- *the offer, if tailored for the third party, is based upon the giftee profile corresponding to the third party and is not based upon the user profile corresponding to the user (see at least column 6, lines 23-37, user designates shopping carts for different people (self, children , etcetera) and recommendations are made based on current shopping cart contents or past shopping cart purchases/selections, but are specific to a particular designated shopping cart),*
- *the offer, if tailored to the user, is based upon the user profile corresponding to the user and is not based upon the giftee profile corresponding to the third party (see at least column 6, lines 23-37, user designates shopping carts for different people (self, children , etcetera) and recommendations are made*

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based on current shopping cart contents or past shopping cart purchases/selections, but are specific to a particular designated shopping cart),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine capacity to differentiate between purchase histories and item selections for various parties within one user's account (the invention of Garrett) with the automated generation of product promotions/recommendations based on shopping cart content and previous purchases (the invention of Jacobi) since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claim 20:**

The combination Garrett/Jacobi discloses the limitations as shown in the rejections above. Garrett does not specifically disclose offers. However, Jacobi, as shown, discloses the following limitation:

- *the determining of the offer is based upon a past purchase transactions and the presented offer is for a future purchase by the user (see at least column 6, line 33-37, uses items that were purchased as basis for offers),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine capacity to differentiate between purchase histories and item selections for various parties within one user's account (the invention of Garrett) with the automated generation of product promotions/recommendations based on shopping cart content and previous purchases (the invention of Jacobi) since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

### **Response to Arguments**

13. Applicant's arguments with respect to claims 1 and 21 have been considered but are moot in view of the new ground of rejection.
14. With regard to claim 10 Applicant asserts that the combination Garrett/Jacobi fails to disclose the limitations of claim 10. This argument is not persuasive because it fails to comply with 37 CFR 1.111(b) because it amounts to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Unlike claims 1 and 21, claim 10 discloses that the limitation "receiving, by the computerized transaction system, from the user an indication of the whether the subject of the computerized transaction is intended for use by the user or by a third party," this limitation does not foreclose an online prompt. Further claim 10 also discloses "distinguishing in the computerized database system, by the computerized transaction system without prompting the user, between the subject...", since this step may occur after receiving the indication from the user, Examiner interpreted this limitation to mean that once the indication is received, the system then maintains the distinction. As noted in the rejection above, Garret discloses compiling separate purchase histories for third parties and the user (see at least figure 6). Accordingly Garrett and Jacobi do disclose all of the limitations of amended claim 10.

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### **Conclusion**

- 15.** Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 8:30am-4:00pm EST. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
- 16.** Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
- 17.** Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**P.O. Box 1450, Alexandria, VA 22313-1450**

or faxed to **571-273-8300**.

- 18.** Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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401 Dulany Street

Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 3622  
13 October 2009

/Arthur Duran/  
Primary Examiner, Art Unit 3622